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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/707,484
Filing Date: December 17, 2003
Appellant(s): GILLINGHAM ET AL.

Jerome Drouillard
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/21/2006 appealing from the Office action mailed 2/1/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct. It is noted that the withdrawn claims (claims 1-10) are included in the claims appendix because claim 11 depends on withdrawn process claim 1.

(8) Evidence Relied Upon

2002/0017805	CARROLL	2-2002
6,086,145	WANDYEZ	7-2000

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll et al. (US 2002/0017805).

Carroll et al. disclose an energy absorbing assembly (Abstract). An upper layer having contours may be combined with a lower layer having contours so that a cavity is formed between the two layers (Figures 13 and 15). Carroll et al. also disclose that the material meets head injury criteria (paragraph 68). With regard to claim 16, Carroll et al. teach other components that may be included in the composite, including delta structures (paragraph 57), acoustic dampeners (paragraph 60), and pellets or beads (paragraph 65). With regard to claims 17-20, the recesses are circular in nature (Figure 11) and Carroll et al. teach other shapes may be used (paragraph 43). With regard to claim 21, Carroll et al. use a thermoplastic sheet (paragraph 51).

3. Claims 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wandyez (U.S. Patent No. 6,086,145).

Wandyez discloses a headliner wherein cavities are formed between the upper substrate and a lower substrate (Abstract). Both upper and lower layers have a plurality of contours

(Figure 1). With regard to claims 14 and 15, both upper and lower layers have convex and concave members (Figure 3). With regard to claim 16, foam or cables may be provided in the cavities (Abstract). With regard to claims 17-20, the shape of the cavities may be rectangular or square (column 4, lines 40-49 and Figure 3). With regard to claim 21, the substrate may be plastic (column 4, line 29).

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carroll et al.

With regard to claim 11, the patentability of a product does not depend on its method of production. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, (Fed. Cir. 1985). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). In this case, Carroll et al. disclose all physical and structural limitations of the product claim.

6. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wandyez.

With regard to claim 11, the patentability of a product does not depend on its method of production. In this case, Wandyez disclose all physical and structural limitations of the product claim.

(10) Response to Argument

Claims 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll.

The appellant asserts that Carroll does not disclose a headliner because the assembly may be attached to a support surface such as a headliner (see claim 10). The appellant asserts that two headliners cannot be attached. The examiner respectfully disagrees.

Firstly, appellant's assertion that two headliners cannot be attached is completely unsupported. It is well settled that unsupported arguments are no substitute for objective evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). It is noted that Carroll discloses that the assembly is a sheet of material ([0033]). Clearly two sheets of material can be attached.

Secondly, the recitation of a headliner is found in the preamble of the claims. This amounts to a recitation of an intended use of the composite material because a headliner is simply material used to cover the interior of an automobile roof. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a

limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett- Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

Thirdly, Carroll discloses that the assembly is a sheet of material ([0033]). Clearly a sheet of material is capable of covering the interior of an automobile roof.

Fourthly, Carroll discloses that the sheet may be attached to a support surface (see claim 10). Considering that an automobile roof is obviously a support surface, the sheet is obviously capable of being attached to an automobile roof and is therefore capable of use as a headliner (being a headliner).

Fifthly, the appellant does not contest that the sheet possesses all of the currently claimed headliner structural limitations. Considering that the sheet possesses all of the currently claimed structural limitations, it is inherently a headliner.

It is noted that the appellant has previously pointed to features of a headliner that are described in the Specification at paragraph 5. However, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wandyez

The appellant asserts that prior to being joined together, there is no separate upper layer and separate lower layer because Wandyez forms passages by blow molding. The examiner respectfully disagrees. Wandyez clearly shows an upper layer and a lower layer and at some location the layers are even separated by cavities (see Figures 3 and 4). Appellant asserts the headliner of the present invention includes top and bottom layers that are independent prior to being joined together. However, the status of the layers prior to being joined together is

immaterial because the claim requires that the top layer and bottom layers be "substantially joined together." Since the claims require joining the top and bottom layers together, the status of those layers as not being joined together prior to their integration is irrelevant.

The appellant asserts that Wandyez does not form a headliner "having a finished inner lower surface in a single step." Firstly, it is not clear where the claim refers to "having a finished inner lower surface in a single step." Secondly, if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carroll

In addition to the arguments set forth above regarding claims 12 and 14-21 being rejected under 35 U.S.C. 102(b) as being anticipated by Carroll (see above response to arguments), the appellant asserts Carroll does not mention vacuum forming. Once again, the examiner contends that if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

The appellant asserts that Carroll does not teach or suggest independent top and bottom layers joined together. The examiner respectfully disagrees. For example, figures 13-15 illustrate independent top and bottom layers joined together.

Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wandyez

In addition to the arguments set forth above regarding claims 12 and 14-21 being rejected under 35 U.S.C. 102(b) as being anticipated by Wandyez (see above response to arguments), the appellant asserts Wandyez does not teach or suggest upper and lower layers that are bonded together. The examiner respectfully disagrees. Wandyez clearly shows an upper layer and a separate lower layer that are bonded together in the blow molding process (see Figures 3 and 4).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

atp

9/22/06

ANDREW T. PIZIALI
PATENT EXAMINER

Conferees:

Terrel Morris

Jennifer Kolb-Michener